

**REMARKS**

Claims 5, 27, 29, and 38 have been canceled without prejudice or disclaimer as to the subject matter recited therein. Thus, claims 1-4, 6-9, 11, 12, 14-20, 22-26, 30, 31, 33-37, and 39 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

**Section 112 Rejections**

Claim 5 was rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement, and more specifically, for claiming subject matter which was not described in the specification in such a way as to enable one skilled in the art to make or use the invention. In an effort to expedite prosecution, claim 5 has been canceled rendering rejection thereto moot. Accordingly, removal of this rejection is respectfully requested.

**Section 103 Rejections**

Claims 1-4, 6-9, 11, 12, 14-20, 22-27, and 29-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,748,186 to Raman (hereinafter "Raman") in view of "Extensible Server Pages (XSP) Layer 1" by Stefano Mazzocchi (hereinafter "Mazzocchi") and in further view of U.S. Patent No. 6,681,370 to Gounares (hereinafter "Gounares"). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Raman, Mazzocchi, Gounares and in view of the Applicants Admitted Prior Art. Claim 5 has been canceled rendering rejection thereto moot.

To establish a case of *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (C.C.P.A. 1974); MPEP 2143.03. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01. The cited art does not teach or suggest each and every limitation of independent claims, some distinctive limitations of which are set forth in more detail below.

N n of the cited art teaches or suggests a syst m, transcoder proxy or method for presenting an electronic document by: (i) assigning a unique identifier to each element of an electronic document received in a first digital format, and (ii) producing an original script that includes at least a portion of the electronic document expressed in a second digital format, along with the unique identifiers assigned to the elements in the portion. Independent claim 37 recites in part:

A method for presenting an electronic document, comprising: receiving the electronic document in a first digital format; assigning a unique identifier to each element of the electronic document; forming a model of a logical structure of the electronic document... using the model to produce an original script, wherein the original script includes at least a portion of the electronic document expressed in a second digital format, and wherein the original script includes at least one element and the identifier assigned to the at least one element...

Independent claims 1 (a system), 14 (a system), 22 (a transcoder proxy) and 39 (a method) recite similar limitations.

Raman discloses "a system [that] can interactively present electronically encoded multi-media information in a plurality of presentation modalities." (Raman, column 2, lines 19-21). In particular, the system of Raman includes a retriever (120, FIG. 1) for receiving a source document (111) in a "first digital format," such as the HTML source document 300 of FIG. 3. The system of Raman further includes a recognizer (130) for parsing the character stream into fundamental source "elements" (e.g., title, sections, sub-sections, paragraphs, sentences, links, forms, etc.), and generating a nested list (400, FIG. 4) representing the source document. Raman discloses that the elements within the nested list can be stored within a data structure (200, FIG. 2) in the form of a hierarchical attributed tree, or "DOM".

Raman does not teach or suggest the presently claimed step of assigning a unique identifier to each element of the source document (i.e., electronic document). However, statements in the Office Action suggest that assigning a unique identifier to each element of the source document is inherently taught by Raman, since the elements "must be given some type of unique identifier for example, a variable name, or a memory location... to be stored in a computer system" (Office Action, page 3). The above Office Action statements are hereby respectfully traversed, for at least the reasons set forth in more detail below.

The Applicant concedes that, when storing a data structure or document, a unique identifier (such as a variable name or memory location) may be used to reference the stored data structure or document. In doing so, the unique identifier may be used to subsequently retrieve the stored data structure or document. However, the Applicant disagrees with the Examiner's contention that the individual elements of the stored document (e.g., the title, sections, paragraphs, images, etc. of the stored document) must also be given a unique identifier to enable the document to be stored. Raman simply does not teach or suggest the presently claimed step of assigning a unique identifier to each element of an electronic document, nor can the teachings of Raman be considered to inherently teach such a step.

Raman also fails to teach or suggest the presently claimed step of producing an original script, wherein the original script includes at least a portion of the electronic document expressed in a second digital format, and wherein the original script includes at least one element and the identifier assigned to the at least one element. Statements in the Office Action admit that Raman fails to disclose the presently claimed step of producing an original script, but suggests that "Mazzocchi teaches a second digital format, including a portion of an original document expressed in a second digital format, with identifiers for elements (p. 7-8)." (Office Action, pages 3-4). The Applicant disagrees, for at least the reasons set forth in more detail below.

Mazzocchi discloses a method for transforming a source document from a first digital format (e.g., XML) into a second digital format (e.g., XSP) by applying a "logic sheet" to insert programming code into the source document. (See, e.g., Mazzocchi, pages 3-6). Contrary to the statements in the Office Action, however, Mazzocchi does not teach or suggest that unique identifiers may be assigned to each element of the source document. As such, Mazzocchi cannot teach or suggest the presently claimed step of producing an original script that includes at least a portion of the electronic document expressed in a second digital format and the unique identifiers assigned to the elements in the portion. As such, Mazzocchi cannot be combined with Raman to overcome the deficiencies therein.

Gounares discloses an HTML/XML tree synchronization module that synchronizes a document with a view or multiple views, after a change has been made to the document. (Gounares, Abstract). However, Gounares cannot be combined with Raman and Mazzocchi in such a manner that teaches or suggests the aforementioned claim limitation. For example, Gounares fails to teach or suggest the presently claimed step of producing an original script that includes at least a portion of the electronic document expressed in a second digital format and the unique identifiers assigned to the elements in the

portion. In fact, though Gounares discloses a method for "updating one or more document views when changes are made to the original document" (Gounares, column 2, lines 65-67), Gounares provides absolutely no teaching or suggestion for expressing at least a portion of the original document in a second digital format. In other words, Gounares does not disclose that the original document may be changed from its original HTML/XML format to another format.

Since none of the cited art teaches or suggests the aforementioned limitations of present claims 1, 14, 22, 37 and 39, the cited art cannot be combined or modified to do so.

None of the cited art teaches or suggests a system comprising: i) a transcoder proxy configured to form a pre-transcoded DOM representing a logical structure of an electronic document, and ii) a client machine configured to form a transcoded DOM representing a portion of the electronic document. Amended independent claim 30 recites in part:

A system for delivering an electronic document, comprising: a transcoder proxy, including: a synchronous document object model (DOM) generator coupled to receive the electronic document in a first digital format... wherein the synchronous DOM generator is configured to: form a pre-transcoded DOM representing a logical structure of the electronic document... and a client machine coupled to receive the original script, wherein the client machine comprises...a user agent... configured to: form a transcoded DOM... wherein the transcoded DOM is a representation of the portion of the electronic document...

Independent claim 30 was only amended to correct antecedent basis; thus, the amendments to claim 30 do not introduce new matter or warrant a new search.

The presently claimed case teaches a system and method for delivering electronic documents (12, FIG. 2), via a transcoder proxy (28), to a client machine (22) having limited resource capabilities. The client machine may be, for example, a palmtop or handheld computer or a wireless communication device with limited memory, display and/or processing capability, among other things. The transcoder proxy receives the document in a first digital format, and produces a pre-transcoded DOM (38), i.e., a representation of the logical structure of the electronic document, to facilitate navigation through the document. In order for the electronic document to be provided to the client machine, a portion of the electronic document is translated (by the transcoder proxy) from the first digital format to a script expressed in a second digital format. The script may include, for example, a subset of the first digital format, converted graphics images, audio files, transcoded Braille, and/or unformatted text. Upon

receiving the original script, the client machine produces a transcoded DOM (42), which contains a representation of the elements within the portion of the electronic document. As such, the presently claimed case discloses the use of two separate DOMs – one (located at the transcoder proxy) containing a representation of the electronic document, and the other (located at the client) containing a representation of a portion of the document. *See, e.g., Specification, pages 11-13.*

As noted above, Raman discloses a means for parsing the “elements” (e.g., title, sections, sub-sections, paragraphs, sentences, links, forms, etc.) of a source document to generate a nested list representing the source document. Raman also discloses that the elements within the nested list can be stored within a data structure (200, FIG. 2) in the form of a hierarchical attributed tree, or “DOM”. Raman, however, does not teach or suggest that data structure 200 is produced within a transcoder proxy, as presently claimed.

In addition, Raman simply fails to teach or suggest that another DOM, and more specifically, a DOM representing only a portion of the document, could be produced by a client machine. Instead, and as noted above, the only DOM structure disclosed by Raman (i.e., data structure 200) is converted by presenter 140 into “multimodal presentations”, which are provided to the user as aural, visual or tactile information. Consequently, Raman does not teach or suggest a system comprising: i) a transcoder proxy configured to form a pre-transcoded DOM representing a logical structure of an electronic document, and ii) a client machine configured to form a transcoded DOM representing a portion of the electronic document, as taught in present claim 30. Accordingly, Raman does not teach or suggest all limitations of present claim 30.

Furthermore, Mazzocchi cannot be combined with Raman to overcome the deficiencies therein. As noted above, Mazzocchi discloses a method for transforming a source document from a first digital format (e.g., XML) into a second digital format (e.g., XSP) by applying a “logic sheet” to insert programming code into the source document. (*See, e.g., Mazzocchi, pages 3-6*). Though Mazzocchi briefly mentions the phrase “DOM tree” (almost in passing), Mazzocchi does not teach or suggest that the DOM tree is produced by a transcoder proxy, nor does he teach or suggest that another DOM, and more specifically, a DOM representing only a portion of the document, could be produced by a client machine. Consequently, Mazzocchi does not teach or suggest all limitations of present claim 30.

Statements in the Office Action admit that "[n]either Raman nor Mazzocchi teach transcoding a DOM tree." (Office Action, page 8). However, further statements in the Office Action suggest that "Gounares teaches a client machine [that] creates a transcoded DOM tree (FIG. 5, 516n)." (Office Action, page 8). The Applicant respectfully disagrees, for at least the reasons below.

In the above Office Action statement, the Examiner suggests that view tree data 516 is equivalent to the presently claimed transcoded DOM. This is simply not true. As recited in present claim 30, the presently claimed transcoded DOM is formed in response to the original script from the transcoder. The original script is formed by translating a portion of the electronic document from the first digital format into a second digital format. As noted above, Gounares fails to provide teaching or suggestion for expressing at least a portion of the original document in a second digital format, and therefore, cannot provide teaching or suggestion for forming a transcoded DOM in response to an original script expressed in the second digital format. Consequently, Gounares cannot be combined with Raman and/or Mazzocchi to overcome the deficiencies therein.

For at least the reasons set forth above, none of the cited art, either separately or in combination, provides motivation to teach or suggest all limitations of claims 1, 14, 22, 30, 37, and 39. Therefore, claims 1, 14, 22, 30, 37, and 39, as well as claims dependent therefrom, are asserted to be patentably distinct over the cited art. Accordingly, removal of this rejection is respectfully requested.

#### CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed February 25, 2004. In view of remarks traversing the rejections, Applicants assert that pending claims 1-4, 6-9, 11, 12, 14-20, 22-26, 30, 31, 33-37, and 39 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-02200.

Respectfully submitted,



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Date: May 25, 2004  
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